

REMARKS

1. In response to paragraph 1 of the Office Action, Applicant has updated information on the Cross-Reference to Applications” from page 1 of the original specification by the proposed amendment to the specification. Please delete paragraphs [0001] and [0002] in the original specification and replace them with paragraphs [0001] and [0002] found in this filing under “Amendments to the Specification”. Applicant respectfully requests that this objection now be withdrawn.
2. In response to paragraph 2 of the Office Action, Applicant acknowledges the Examiner’s citation to 35 U.S.C. § 101.
3. In response to paragraph 3 of the Office Action, Applicant respectfully objects with traverse to the non-statutory rejection of original claims 17-20. Based on the telephone discussion with Examiner Nguyen, please delete paragraph [0061] in the original specification and replace it with paragraph [0061] found in this filing under “Amendments to the Specification.” Accordingly, Applicant respectfully requests that this rejection now be withdrawn based on the telephone discussion with Examiner Nguyen.
4. In response to paragraph 4 of the Office Action, Applicant acknowledges the Examiner’s citation to 35 U.S.C. § 102 (e).
5. In response to paragraph 5 of the Office Action, Applicant acknowledges the Examiner’s citation to Erev *et al.* (U.S. Publication No. 2003/0084106) as forming the basis for the Office Action’s rejection of Applicant’s claims 1, 2, 4-13, 15-18, and 20 under 35 U.S.C. § 102 (e). Applicant objects with traverse to Erev anticipating Applicant’s claims 1, 2, 4-13, 15-18, and 20.

Before turning to the law and reasons why Erev does not anticipate Applicant’s original claims, Applicant notes that it has presented amended claims that do not add new matter. Specifically, Applicant’s proposed amended claim 1, and by analogy independent claims 9

and 17, has been amended to add further clarity to show that the call is to code, itself, which is generated and retrieves the email attachment(s) associated with an email for forwarding the stripped email with the call to a recipient. This further clarity provides a further showing that Erev does not anticipate Applicant's amended claim 1, and by analogy independent claims 9 and 17.

For a claim to be anticipated, Erev must describe each element and limitation of that claim.¹ Further, Erev "must also enable one of skill in the art to make and use the claimed invention."² Below, Applicant shows that Applicant's amended claim 1, and by analogy amended claims 9 and 17, are not anticipated by Erev as a matter of law.

Simply, **nowhere** does Erev describe Applicant's generating claim element in amended claim 1 and limitation in amended claim 1 that an email attachment is called by a piece of generated code. Applicant's code to transmit the email attachment is to an activated call to generate code, wherein the call may be represented by a hyperlink to the generated code to forward the email. Quite differently, Erev has a direct pointer to the remote audio and visual multimedia content only described therein. As a matter of law, therefore, Erev fails to anticipate Applicant's amended claim 1 since it fails to disclose both Applicant's generating code element and Applicant's claim limitation of calling an email attachment by a piece of generated code. Accordingly, since amended claim 1 is not anticipated by Erev under § 102 (e), then any and all claims depending therefrom are also not anticipated.³ And, by analogy, amended claims 9 and 17 are neither anticipated by Erev under § 102 (e), and nor are any of the claims depending therefrom.⁴

In addition and in the alternative, since neither Applicant's generating code element nor Applicant's claim limitation of calling an email attachment by a piece of generated code is present in Erev, such would not "enable one of skill in the art to make and use Applicant's

¹ *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

² *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985).

³ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

⁴ *Id.*

claimed invention.”⁵ Once again, none of Applicant’s amended, independent claims 1, 9 or 17 are anticipated by Erev under § 102 (e), and likewise are any of their dependent claims.⁶

6. In response to paragraph 6 of the Office Action, Applicant acknowledges the Examiner’s citation to 35 U.S.C. § 103 (a).
7. In response to paragraph 7 of the Office Action, Applicant acknowledges the Examiner’s citation to Erev *et al.* (U.S. Publication No. 2003/0084106) in view of Hanna *et. al.* as forming the basis for the Office Action’s rejection of Applicant’s claims 3, 14 and 19 under 35 U.S.C. § 103 (a). Applicant objects with traverse to Erev in view of Hanna rendering obvious Applicant’s claims 3, 14 and 19.

Since paragraph 5 of the Remarks herein shows that Applicant’s amended, independent claims 1, 9 or 17 are not anticipated by Erev, and the Office admits that Erev does not render any of Applicant’s original, independent claims as obvious, then none of Applicant’s claims are obvious under Erev in view of Hanna.⁷ Accordingly, Applicant respectfully requests withdraw of all obviousness rejections as a matter of law.

8. In response to paragraph 8 of the Office Action, Applicant acknowledges the Examiner’s citation to three pieces of prior art that the Examiner views as pertinent to Applicant’s disclosure.

⁵ *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985).

⁶ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

⁷ *Id.*

CONCLUSION

Based on the foregoing amendments to both the specification and claims, as well as the remarks and telephonic discussion with Examiner Nguyen, Applicant respectfully submits that the instant application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney using the contact information found in his signature block below.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

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/Erik J. Osterrieder/
Erik J. Osterrieder
Reg. No. 48,966
Schubert Osterrieder & Nickelson PLLC
6013 Cannon Mtn. Dr., S14
Austin, TX 78749
Tel: (713) 533-0494
Fax: (512) 301-7301
E-mail: ejo@sonlaw.com
ATTORNEY FOR APPLICANT/ASSIGNEE